

the fabric were elastic then the bladders would not bulge inwardly and would "destroy the Taheri reference." This is not true. Even if the outer shell of Taheri were made of rubber, it would still bulge inwardly, though to a lesser degree. Indeed, this is one of the shortcomings of the prior art which Applicants seek to overcome.

Conceding that the cloth fabric outer shell of Taheri might not be inelastic, the Examiner takes the alternative position that it would be obvious to modify Taheri "to provide good pressure against the deep veins." However, in rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art to arrive at Applicants' claimed invention. There must be something *in the prior art* that suggests the proposed modification, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). In this case, once again, there is absolutely no teaching or suggestion *in the prior art*, regarding the Examiner's proposed rejection.

The Examiner goes on to dismiss numerous dependent claims, stating that they "merely recite details of timing and intended use." It is the intention of dependent claims to "recite details." The "intended use" to which the Examiner is referring instead represents positive limitations that must be considered. The Examiner states that "clearly these limitations of intended use are obvious practical considerations dependent of [sic] the specific patient and desired therapy." Who, exactly, are "these limitations" clear to? To whom are they practical? The Examiner adds that "clearly the programmable operation of the pulse generator is capable of being programmed to perform whatever desired time intervals [sic] desired." What substantive evidence is being used to draw such conclusions?

According to the Examiner, "there is no unobviousness to find the optimum operational characteristics for a particular therapy." Is the Examiner one of ordinary skill in the art? On what authority is the Examiner relying for these statements? According to the Examiner "the only difference between the claimed invention and Taheri is the exact timing or operation of inflation of the bladders." Even if that were true, which it is not, such improvements in and of themselves should be at least considered in terms of patentability. The Examiner's statement that "there are no structural differences between the claims and the Taheri device" is simply without merit. Among other procedural mandates, the Examiner is reminded of 35 U.S.C. §112, last paragraph, which states that:

“An element in a claim for a combination may be expressed as a means or step for performing a specified function *without the recital of structure*, material, or acts in support thereof, and such claims shall be constructed to cover the corresponding structure, material, or acts described in the specifications and equivalents thereof.” (Emphasis added)

Claim 22 adds to claim 21 the limitation that “the controller is operative the vary the level of compression as a function of time.” The Examiner is respectfully requested to either produce a reference relevant to the rejection of this claim, or allow it. Claim 23 adds to claim 21 that “the controller is operative to vary the onset of decompression as a function of time.” The Examiner is respectfully requested to either produce a reference relevant to the rejection of this claim, or allow it. Claim 24 adds to claim 21 the limitation that “the controller is operative to reduce the rate of cycling between compression and decompression as a function of time.” The Examiner is respectfully requested to either produce a reference relevant to the rejection of this claim, or allow it. Claim 25 adds to claim 21 the limitation that “the reduction in cycling between compression and decompression drops off slowly over the course of several days.” The Examiner is respectfully requested to either produce a reference relevant to the rejection of this claim, or allow it. Claim 26 adds to claim 21 the limitation that “the rate of cycling between compression and decompression gradually reduces to one cycle every several minutes.” The Examiner is respectfully requested to either produce a reference relevant to the rejection of this claim, or allow it. Claim 27 adds to claim 21 the limitation that “the rate of cycling between compression and decompression gradually reduces to one cycle every hour or longer.” The Examiner is respectfully requested to either produce a reference relevant to the rejection of this claim, or allow it.

Claim 28 further includes the structural limitation of a user operable control for switching between a fixed rate of compression and decompression and an automatic mode wherein the cycling reduces over time. Again, the Examiner is respectfully requested to either produce a reference relevant to the rejection of this claim, or allow it. Claim 32 adds to claim 21 the structural limitation that the inelastic outer shell is dimensioned for wearing around an upper portion of a human calf. The Examiner is respectfully requested to either produce a reference relevant to the rejection of this claim, or allow it.

Independent claim 38 includes a limitation of a controller operative, among other functions, to “reduce the rate of cycling between compression and decompression as a function of time.” The

Examiner is respectfully requested to either produce a reference relevant to the rejection of this claim, or allow it. Claim 29 adds to claim 21 the limitation of a pressure sensor in pneumatic communication with the bladder to terminate the operation of a compressor upon reaching a desired level of positive pressure. The Examiner apparently concedes that Taheri discloses nothing regarding the use of a pressure sensor, but combines Tumey et al. '801 with Taheri et al. '458 *with no teaching or suggestion to do so from the prior art*.

Claim 31 adds to claim 21 the limitation that the substantially inelastic outer shell forms part of a cast. Even though the Examiner previously argues that the fabric of Taheri is substantially inelastic, the Examiner combines Taheri and Vinmont, the latter teaching the use of a cast for an entirely different purpose. The Examiner states that "it would have been obvious to one of ordinary skill in the art to modify Taheri to use it in combination with a cast as taught by Vinmont since the art of improving cardiocepal venous flow applies to people in casts who are likewise ambulatory as well as taught by Vinmont." What support does the Examiner have regarding such statement regarding the "art of improving cardiocepal venous flow?" The Examiner is respectfully requested to either produce a teaching or suggestion from the prior art in support of this and other references, or allow the claim(s) at issue.

Claim 35 adds to claim 21 the limitation that the substantially inelastic outer shell is dimensioned for wearing around at least a portion of the human hand. Since Taheri is "clearly" directed to "aiding cardiocepal venous flow from the foot and leg of an ambulatory patient" (see U.S. Patent No. 4,941,458 title), the Examiner attempts to combine another reference, namely that of Corcoran, which resides in a hand or foot carried pulsating massaging device. The Examiner states that this combination would have been obvious "for those people who need to stimulation [sic] of those limb extremities." According to this reasoning, then, whatever body part Applicants' might mention, it would be obvious in view of the Examiner's opinion.

Claim 36 adds to claim 21 that the substantially inelastic outer is substantially rigid. Again, given that Taheri contains no such teaching or disclosure, the Examiner attempts to combine the teachings of Johnson, Jr. ('262) on the grounds that "to use a rigid outer shell as taught by Johnson as obvious equivalent alternative [sic] for the cuff." There is simply no support or justification for these or the other combinations suggested herein.

Based on the foregoing, Applicants believe all claims continue to be in condition for allowance..

Respectfully submitted,

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Date: Dec. 10, 2002

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CERTIFICATE OF MAILING (37 CFR 1.8(a))

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Date: 1-7-03

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